

Serial No.: 10/027,226

Confirmation No.: 9039

Filed: 20 December 2001

For: METHODS AND DEVICES FOR REMOVAL OF ORGANIC MOLECULES FROM BIOLOGICAL MIXTURES USING A HYDROPHILIC SOLID SUPPORT IN A HYDROPHOBIC MATRIX

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**Remarks**

The Office Action mailed 24 August 2006 has been received and reviewed. Claims 1, 20, 26, 28, 47, 50, and 78 having been amended, claims 79-81 having been added, and no claims having been canceled herein, the pending claims are claims 1, 3-28, 30-55, 62-67, and 77-81. Claims 1, 3-28, and 30-49 having been withdrawn from consideration by the Examiner as being directed to non-elected groups, claims 50-55, 62-67, and 77-81 are currently under consideration.

Claims 1, 20, 26, 28, 47, 50, and 78 have been amended to recite that "the solid hydrophilic particles comprise molecules different than the hydrophobic matrix," which is supported by the specification in general, and specifically at, for example, page 10, line 8 to page 13, line 11; page 19, line 7 to page 20, line 3; and page 27, line 20 to page 28, line 3.

New claims 79-81 are supported, for example, by originally filed claims 5 and 6.

Reconsideration and withdrawal of the rejections are respectfully requested.

**Provisional Obviousness-Type Double Patenting Rejection**

Claims 50-53 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 53 and 56-58 of copending Application No. 10/417,609 in view of Dusterhoft (U.S. Patent No. 6,451,260). Claims 50-53 were provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 39-42 of copending Application No. 10/417,609 in view of Dusterhoft (U.S. Patent No. 6,451,260).

Upon an indication of otherwise allowable subject matter and in the event this rejection is maintained, Applicants will provide an appropriate response. In the event that the provisional obviousness-type double patenting rejections are the only rejections remaining in the present application, the Examiner is respectfully requested to withdraw the provisional obviousness-type double patenting rejection and allow the present application to issue as a patent pursuant to M.P.E.P. §822.01.

### **Rejections under 35 U.S.C. §103**

The Examiner rejected under 35 U.S.C. §103(a) claims 50-52, 64-65, and 77-78 as being unpatentable over Nelson et al. (U.S. Patent No. 6,344,326) in view of Dusterhoft et al. (U.S. Patent No. 6,451,260); claim 53 as being unpatentable over Nelson et al. in view of Dusterhoft et al. as applied above, and further in view of Mian et al. (U.S. Patent No. 6,319,469); claims 54-55 and 66-67 as being unpatentable over Nelson et al. in view of Dusterhoft et al. as applied above, and further in view of Chisolm et al. (U.S. Patent No. 4,399,009); and claims 62 and 63 as being unpatentable over Nelson et al. in view of Dusterhoft et al. as applied above, and further in view of Kellogg et al. (U.S. Patent No. 6,632,399). These rejections are respectfully traversed.

“To establish *prima facie* obviousness of a claimed invention, all the claim limitations must be taught or suggested by the prior art.” *In re Royka*, 490 F.2d 981, 180 USPQ 580 (CCPA 1974), M.P.E.P. §2143.03. Appellants respectfully submit that the Examiner has failed to establish a *prima facie* case of obviousness.

Independent claims 50 and 78 each clearly recite solid hydrophilic particles that are partially embedded within a hydrophobic matrix. As admitted by the Examiner, "Nelson does not teach a solid phase extraction material comprised of a hydrophilic solid support partially embedded within a hydrophobic matrix" (page 6 of the Office Action mailed 14 December 2004). Instead, the Examiner is relying on Dusterhoft et al. to provide that which is missing from Nelson et al.

Thus, an issue that remained in dispute was whether Dusterhoft et al. teach solid hydrophilic particles that are partially embedded within a hydrophobic matrix. Applicants respectfully submit that Dusterhoft et al. fail to teach or suggest that which is missing from Nelson et al. for at least the reasons of record (e.g., the remarks on pages 16-20 of the Amendment and Response submitted 11 March 2005).

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However, in an earnest effort to advance the prosecution of the present application, independent claims 50 and 78 have been amended to further recite that "the solid hydrophilic particles comprise molecules different than the hydrophobic matrix." Applicants respectfully submit that the present claim language is neither taught nor suggested by Dusterhoft et al., which discloses a segmented polymer that is relied upon by the Examiner as forming a solid hydrophilic particle from one segment and a hydrophobic matrix from another segment (e.g., pages 5-6 of the Office Action mailed 24 August 2006).

Thus, Applicants respectfully submit that all the claim language is neither taught nor suggested by the cited art, and that the Examiner has failed to establish a *prima facie* case of obviousness. Based on the remarks presented herein, Applicants respectfully request that the Examiner reconsider and withdraw the rejections under 35 U.S.C. §103.

### **New Claims**

New claims 79-81 depend directly or ultimately from independent claim 78. Applicants respectfully submit that new claims 79-81 are patentable for at least the reasons of record for the patentability of independent claim 78, in addition to the subject matter further recited in each.

Entry and consideration of new claims 79-81 are respectfully requested.

### **Request for Rejoinder**

Claims 1, 3-28, and 30-49 recite methods of using a device as recited, for example, in claims 50 and/or 78. Specifically, independent claims 1, 20, 26, 28, and 47 recite language from independent claims 50 and 78. Upon an indication of claim 50 or 78 being allowable, Applicants respectfully request that the method claims (e.g., claims 1, 3-28, and 30-49) also be examined and passed on to allowance pursuant to M.P.E.P. §821.04. *See, for example, In re Ochiai*, 71 F.3d 1565, 37 USPQ2d 1127 (Fec. Cir. 1995) and *In re Brouwer*, 77 F.3d 422, 37 USPQ2d 1663 (Fed. Cir. 1996).

**Amendment and Response**

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**Summary**

It is respectfully submitted that all the pending claims are in condition for allowance and notification to that effect is respectfully requested. The Examiner is invited to contact Applicants' Representatives, at the below-listed telephone number, if it is believed that prosecution of this application may be assisted thereby.

Respectfully submitted

By

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November 21, 2006

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**CERTIFICATE UNDER 37 CFR §1.10:**

"Express Mail" mailing label number: EV 201 878 435 US

Date of Deposit: November 21, 2006

I hereby certify that the Transmittal Letter and the paper(s) and/or fee(s), as described hereinabove, are being deposited with the United States Postal Service "Express Mail Post Office to Addressee" service under 37 CFR §1.10 on the date indicated above and is addressed to: **Mail Stop RCE**, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

By: 

Name: Sue Dombroske

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